

REMARKS

Claims 1-34 are pending in this application. Claims 1 and 18 are independent. In light of the remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over *Sklarew* (USP 5,157,737) in view of *Dymetman et al.* (USP 6,330,976). Applicants respectfully traverses these rejections.

Claim Rejections - 35 U.S.C. § 103

With regard to the Examiner's rejection of claim 1, the Examiner asserts that *Sklarew* discloses a method for generating an association with regard to information which is arranged on at least one support provided with a position coding pattern by disclosing sensing when the handheld device passes over a discontinuity, citing to Figs. 11F and 11H, in the position coding pattern; interpreting the discontinuity in the absolute position coding pattern (failing to cite to any support in the *Sklarew* reference in support of this assertion); and interpreting the discontinuity as an association regarding the information present on the support, citing to Fig. 10. Applicants respectfully disagree with the Examiner's characterization of this reference.

In order to sustain a claim rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that *Sklarew* discloses a handwritten keyboardless entry computer system which includes a transparent input screen that generates positional information when contacted by a stylus. The system further includes a computer that has been programmed to compile positional information into strokes, to calculate stroke characteristics, and compare the stroke characteristics with those stored in a database in order to recognize the symbol drawn by the stylus (Abstract).

Sklarew discloses in Figs. 11A-11I some of the simplifications in word processing that may be experienced utilizing the *Sklarew* invention. Specifically, *Sklarew* discloses in col. 12, ll. 25-38:

The user of the keyboardless entry system decides that additional information needs to be added and draws an insert symbol (e.g., caret) on the screen at the desired position. A data entry "window" then appears. (FIG. 11B). The text is written in as Handwritten Symbols (FIG. 11C), matched (converted to Font Symbols) (FIG. 11D), and then inserted (FIG. 11E). The operator reconsiders the addition and draws a horizontal line through the new material (FIG. 11F). It is immediately erased. (FIG. 11G). Next, the operator decides that a larger right-hand margin would be more appropriate for the text. A vertical line is drawn on the screen (FIG. 11H) and the margin is automatically adjusted (FIG. 11I).

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, a method for generating an association with regard to information, the method including sensing when the handheld device passes over a discontinuity in the absolute position coding pattern. The Examiner relies on Figs. 11F and 11H of *Sklarew* to teach "sensing when the handheld device passes over a discontinuity." As depicted in Figs. 11F and 11H, *Sklarew* merely discloses allowing the user to perform a right-hand margin adjustment by drawing a vertical line on the screen (Fig. 11H) where the margin is automatically adjusted (Fig. 11I). Additionally, Fig. 11F discloses allowing a user to erase new material that has been inserted by drawing a horizontal line through the new material. It is respectfully submitted that this disclosure of *Sklarew* fails to teach or suggest sensing when a handheld device passes over a discontinuity as recited in claim 1.

As such, it is respectfully requested that the outstanding rejection be withdrawn.

As noted above, in order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must provide a reference that teaches or suggests all of the claimed elements. In the outstanding rejection, the Examiner asserts that *Sklarew* discloses interpreting the discontinuity in the absolute position coding pattern. However, the Examiner fails to provide any citation to the *Sklarew* reference in support of this assertion. It is respectfully submitted that *Sklarew* fails to teach this element. As such, should the Examiner maintain the outstanding rejection, the Examiner is respectfully requested to provide a detailed explanation of how the references teach or suggest this claimed element in a non-final Official Action.

Finally, the Examiner asserts with regard to claim 1 that *Sklarew* discloses interpreting the discontinuity as an association regarding the information present on the support, citing to Fig. 10. Applicants respectfully disagree with the Examiner's characterization of this reference.

It is respectfully submitted that Fig. 10 of *Sklarew* provides for a series of learning screens that are displayed to the user. The user is prompted to write the numbers 0-4 where the computer will attempt to match the written numbers with an existing

database. The learning process continues until all of the alphanumeric characters and symbols to be used are entered into the database.

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, a method for generating an association with regard to information where the method includes interpreting the discontinuity as an association regarding the information present on the support. It is respectfully submitted that while *Sklarew* may disclose an association between the user's handwritten alphanumeric characters and symbols to those existing in a database, *Sklarew* fails to teach or suggest interpreting the discontinuity as an association regarding the information present on the support as recited in claim 1. Additionally, as noted above, *Sklarew* fails to teach or suggest a discontinuity in the absolute position coding pattern.

It is respectfully submitted that *Dymetman et al.* fails to cure the deficiencies of the teachings of *Sklarew* as *Dymetman et al.* fails to teach or suggest sensing when the handheld device passes over a discontinuity in the absolute position coding pattern. Additionally, *Dymetman et al.* fails to teach or suggest interpreting the discontinuity as an association regarding the information present on the support. As such, *Dymetman et al.* fails to cure the deficiencies of the teachings of *Sklarew*. Thus, as the

Examiner has failed to provide references that teach or suggest all of the claimed elements, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. Thus, it is requested that the outstanding rejections be withdrawn.

It is respectfully submitted that claims 2-17 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1. It is further respectfully submitted that claim 18 contains elements similar to those discussed above with regard to claim 1 and, thus, claim 18, together with claims dependent thereon, are allowable at least for the reasons set forth above with regard to claim 1.

Additional Remarks

On August 28, 2001, Applicants filed an Information Disclosure Statement. To date, Applicants have not received a signed copy of Form PTO-1449. Applicants respectfully request consideration of the documents contained in the Information Disclosure Statement.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinnet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview

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in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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